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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,479	12/17/2001	Domingo Rohde	81,485/LPK	2759

7590

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,479

Applicant(s)

ROHDE ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12, 14 and 17-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on Aug. 4, 2004, has been entered.

2. The examiner acknowledges the amendments to claims 12 and 19 filed on Sep. 16, 2004. Claims 1-12, 14, and 17-20 are pending.

Claims 1-11 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. The election in the reply filed on Oct. 6, 2003, has been treated as an election made without traverse.

3. The amendment filed on May 7, 2004, was entered upon the filing of the RCE on Aug. 4, 2004. However, the "Amendment to the claims" section filed on May 7, 2004, was held not to be in compliance with 37 C.F.R. 1.121 for the reasons discussed in the Notice of Non-compliant Amendment mailed on Sep. 2, 2004.

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Accordingly, the "Amendment to the claims" section filed on May 7, 2004, was not entered.

4. The objection to the drawing set forth in the office action mailed on Feb. 5, 2004 (CTFR02052004), paragraph 4, has been withdrawn in response to the replacement drawing of Figure 1 filed on May 7, 2004.

The objection to the specification under 35 U.S.C. 132, set forth in CTFR02052004, paragraph 5, has been withdrawn in response to the amended paragraph beginning at page 5, line 12, of the specification, filed on May 7, 2004.

The objection to the specification set forth in CTFR02052004, paragraph 6, has been withdrawn in response to the amendment to claim 12 filed on Sep. 16, 2004.

The rejection of claim 17 under 35 U.S.C. 112, second paragraph, set forth in CTFR02052004, paragraph 8, has been withdrawn in response to the amendment to claim 12 filed on Sep. 16, 2004.

The rejections of claims 12, 14, and 17-20 under 35 U.S.C. 112, first paragraph, set forth in CTFR02052004, paragraph 10, have been withdrawn in response to the amendments to claims 12 and 19 filed on Sep. 16, 2004.

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5. The amendment filed on May 7, 2004, entered upon the filing of the RCE on Aug. 4, 2004, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows:

The amended paragraph beginning at page 5, line 12, of the specification, stating that "[I]t is of course well known in the toner industry that '%' bases of compositions is 'by weight.'" However, since the specific gravities are similar here, the bases can be either 'weight' or 'volume.'"

There is no disclosure in the originally filed specification that recognizes that it is "well known in the toner industry that '%' bases of compositions is 'by weight'" as stated in the amended paragraph. Nor does the originally filed specification recognize the fact that "since the specific gravities are similar here, the bases can be either 'weight' or 'volume,'" as stated in the amended paragraph. The originally filed specification at page 5, lines 14-15, discloses that "the color black is formed or formed together with at least one toner layer that has a carbon black portion of less than 2%, preferably noticeably less than 2%." The specification did not

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identify the basis of the 2%. There is no evidence in the originally filed specification that would have led a person having ordinary skill in the art to recognize readily that the amount of less than 2% is based on weight. Even if the statements in the amended paragraph were "obvious" to a person having ordinary skill in the art, and there is no evidence in the record supporting such as legal conclusion, they would not be the basis for written description. See Lockwood v. American Airlines, 41 USPQ2d 1961, 1966 (Feb.Cir. 1997) ("Entitlement to a filing date does not extent to subject matter which is not disclosed but would be obvious over what is expressly disclosed. It extends only to that which is disclosed . . . a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.")

Applicants are required to cancel the new matter in the reply to this Office Action.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12, 14, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is indefinite for the following reasons:

(1) It is not clear what is being claimed, e.g., toners or a layer comprising toners, because claim 12 and the dependent claims 14 and 17-20 describe the properties of a "toner layer" rather than the toners.

(2) The phrase "the toners in a toner layer have absorption properties . . . so as to absorb less than 10% of the energy" because it is not clear to what the absorption of the toners in a toner layer are being compared. Furthermore, it is not clear whether the term "the toners" refers to the "toners" recited at line 1 of the claim 12.

(3) The phrase "[t]oners, for a color printer and/or copier device, where a toner layer, having different color pigmented particles, is suitable to produce the color or black . . . characterized in that, the toners in a toner layer have absorption properties . . ." (emphasis added) is indefinite because it is not clear whether the term "different color pigmented particles" refers to the toners for a color printer

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and/or copier device or to "the toners in a toner layer." Nor is it clear whether the toner layer in the phrase "toners in a toner layer" having absorption properties refers to the toner layer having different color pigmented particles or to a different toner layer. In addition, the phrase "produce the color or black" is indefinite for lack of antecedent basis. It is not clear to what "the color or black" refer (e.g., to a color or black image, toner.).

Claim 19 is indefinite in the phrase "the toner layer contains a portion of carbon black of less than 2%" because it is not clear what is the basis of said percentage (e.g., weight, volume, etc.). The claim does not identify the basis of said percentage.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 12, 14, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) Instant claim 12 and claims 14 and 17-20, which depend from claim 12, recite "toners in a toner layer have absorption properties . . . so as to absorb less than 10% of the energy to produce colors or black" (emphasis added).

The originally filed specification does not provide an adequate written description of said toners in a toner layer. The originally filed specification at page 3, line 30, to page 4, line 2, discloses that "in order to produce the color black at least one toner layer is used that has similar absorption properties, at least for one wavelength within a predetermined wavelength range for the electromagnetic radiation, as the other toner layers that are used" (emphasis added). The specification does not disclose that different toners in the same toner layer have the absorption property recited in instant claim 12. The originally filed specification further discloses that the toner that produces the color black, which "has similar absorption properties . . . as other customary toners that are provided to produce colors other than black," "absorbs less than 10% of the energy when it is

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irradiated with electromagnetic radiation with a wavelength in the IR range below approximately 5 μm ." See the originally filed specification, page 6, lines 14-19, and page 7, lines 5-8. In other words, the specification discloses that a toner that produces the color black absorbs preferably less than 10% of the electromagnetic radiation when the toner that produces the color black is irradiated with electromagnetic radiation with a wavelength in the IR range of below approximately 5 μm . The specification does not disclose that "toners in a toner layer . . . absorb less than 10% of the energy to produce colors" (emphasis added) as recited in instant claim 12.

(2) Claim 12 also recites "a toner layer, having different color pigmented particles, is suitable to produce "the color."

The originally filed specification does not disclose that a toner layer having different color pigmented particles is suitable to produce "the color" as recited in instant claim 12. Rather, the originally filed specification discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers is "formed or formed together with at least one toner layer that contains different colored color pigment particles . . . [which] can, for example be formed by color pigment particles that are usually used for the colors cyan, magenta, and yellow." See the

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specification, page 5, lines 2-5. There is no disclosure in the originally filed specification of a toner layer comprising a combination of pigmented particles as recited in instant claim 12 that is suitable to produce "the color."

(3) Claim 17, which depends on claim 12, recites that the toner layer contains a combination of different colored particles that are provided to produce the colors cyan, magenta, and yellow.

The originally filed specification does not provide an adequate written description of the toner layer recited in instant claim 17. The originally filed specification does not disclose that a toner layer having different color pigmented particles that is suitable to produce "the color" comprises a combination of different color pigmented particles that produce the colors cyan, magenta, and yellow, as recited in instant claim 17. Rather, the originally filed specification discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers is "formed or formed together with at least one toner layer that contains different colored color pigment particles . . . [which] can, for example be formed by color pigment particles that are usually used for the colors cyan, magenta, and yellow." See the specification, page 5, lines 2-5. There is no disclosure in the

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originally filed specification of a toner layer comprising a combination of pigmented particles as recited in instant claim 17 that is suitable to produce "the color."

(4) Instant claim 18, which depends from claim 12, further recites that the toner layer recited in claim 12 is "not pigmented with carbon black."

The originally filed specification does not provide an adequate written description of said toner layer. The specification does not disclose that a toner layer that is suitable for producing "the color," comprises different color pigmented particles and further comprises no carbon black, as recited in instant claim 18. Rather, the originally filed specification at page 5, lines 6-8, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers, is "formed or formed together with at least one toner layer that is not pigmented with carbon black." There is no disclosure of a toner layer that is suitable for producing "the color" as recited in instant claim 18.

(5) Instant claim 19, which depends from claim 12, further recites that the toner layer recited in claim 12 that is suitable to produce "the color" contains a portion of carbon black of less than 2%."

The originally filed specification does not provide an adequate written description of said toner layer. The originally filed specification at page 5, lines 13-15, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers, is "formed or formed together with at least one toner layer that has a carbon black portion of less than 2%, preferably noticeably less than 2%." The specification does not disclose that a toner layer that is suitable to produce "the color" comprises different color pigmented particles and carbon black, as recited in instant claim 19.

(6) Instant claim 20, which depends from claim 12, recites that the toner layer recited in claim 12 contains neutral gray pigments.

The originally filed specification does not provide an adequate written description of said toner layer. The specification does not disclose that a toner layer that is suitable to produce "the color" comprises different color pigmented particles and neutral gray pigments, as recited in instant claim 20. Rather, the originally filed specification at page 5, lines 25-26, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers is "formed or formed together

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with at least one toner layer that contains neutral gray pigments free from carbon black particles." There is no disclosure of the toner layer suitable to produce "the color" as recited in instant claim 20.

10. Claims 14 and 17-20 are objected to because of the following informalities:

Claims 14 and 17-20 recite "[t]oner according to claim 12." However, claim 12, from which claims 14 and 17-20 depend, recites "[t]oners" (emphasis added). There is a number mismatch between claim 12 and claims 14 and 17-20.

Appropriate correction is required.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Oct. 16, 2004

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1700